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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,773	12/31/1998	GREGORY S. LINDHORST	3797.09761	3335

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EXAMINER

QUELER, ADAM M

ART UNIT PAPER NUMBER

2179

DATE MAILED: 05/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/223,773

Applicant(s)

LINDHORST ET AL.

Examiner

Adam M Queler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/24/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed on 02/17/2005 and IDS filed 02/24/2005.
2. Claims 1-20 are pending in the case. Claims 1, 8, and 17 are independent claims. Claims 17-20 have been withdrawn.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1-16 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.**

The claims have now been amended many times trying to ascertain the scope and meaning of the claims. Over this time the scope and even definitions of terms have come in to question have been clarified. For example, in the original claims it was unclear what the "event driven programs" were since they were being converted. This amendment now makes it appear that the programs are in fact the actual editors used to edit the objects. This now makes claims 6 and 7 make sense. However, the basic underlying problem is that the claim language does not correspond to the specification. This creates a situation where it appears one trying to replicate the claimed invention would have to resort to undue experimentation to even understand the

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claims in view of the invention, much less replicate the invention. To prove this Office will analyze the claims and try to point out where the confusion lies.

For example, the Office believes that the bulk of Applicant's claimed invention is explained on pp. 24-30. The problem is it is never explained in the claim language. The plain meaning of the claims is vague and the specification does not explain them. While Applicant is permitted to define his terms, they must be defined when their plain meaning is not apparent, and they must not be abhorrent to the actual meaning. For example, claim 1 recites an object. What is the object? Is it the page or the button? What does a visual representation of it entail? Is it code or a picture? The claim later says the visual representation is displayed by the computer code as an event-driven format? Was the original representation an event driven format? What is an event-driven format? Event-driven format's plain meaning would imply that the event handler's code is shown, (for example "and" "onclick" handler) but that doesn't appear to be the claimed meaning.

Or is the processor simply processing the "computer code" *and* cause the display device to display the representation? In that case what does this "processing" entail? The problem is there is no way to know what the "code" is. There are numerous snippets of code in the example. The only clue is that it corresponds to the object in some abstract way. But the identity of the object is also in question. The code is then outputted and modifies the object and then they are displayed together. This is also vague based on the questions above. As one of ordinary skill in the art would undoubtedly have to ask these questions above, the Office submits that this is a reasonable showing undue experimentation is required.

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Another possible miscommunication between the Office and the Applicant is the term ‘event-driven.’ The plain meaning of event-driven is responding to an event such as a mouse click are certain condition being set. Object-oriented programming is best exemplified by the section in Hanson col. 7 line 53–col. 8 line 18. Objects can communicate with events, but not necessarily. Not all event-driven programs are objects, and not all objects are event-driven.

5. **Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Although it still unclear as described above, Applicant appears to be changing event-driven representations to non-event driven. Applicant does not appear to have invented a way of doing this in the broad sense. In the example, (pp. 24-30) there is manipulation of an ‘onclick’ handler. However, no matter what the inventions manipulation is, that is still dependent on an event of ‘onclick’ and is still event driven.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the enablement rejection above, the Office outlined several questions as to the scope and meaning of these claims. These questions render the scope of the claim indeterminate.

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From the specification the invention appears to be converting between the object level of web site (the design-time environment) and actual HTML/ASP code (run-time space). As this is how the claims were interpreted previously, for examining purposes only the previous rejections will stand until the scope of the claims is made determinate enough to determine whether or not they have overcome the prior art.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hanson et al (US005956736A, filed 9/27/1996), and further in view of Popp (US006651108B2, filed 8/14/1995).**

Regarding independent claim 1, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39), which also can be event-driven (col. 8, ll. 10-17). Hanson teaches converting and outputting HTML that is a representation of the object (col. 4, ll. 43-45). Hanson does not teach reconvert HTML to objects. Popp teaches converting an HTML document into objects based on the HTML. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Popp with Hanson because the text form of HTML cannot be easily extended and specialized like objects can (Hanson, col. 4, ll. 19-20).

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Regarding dependent claim 2, Hanson teaches client receiving HTML (serial execution code) from a server (col. 3, ll. 23-29). All programs (objects) on all web pages “operate between a client and a server” as they are transmitted. Hanson teaches an editor that treats all objects the same; therefore, it is shown as operating as if they are on a single machine (col. 4, ll. 26-39).

Regarding dependent claim 3, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39).

Regarding dependent claim 4, Hanson teaches adding scripts to a script library for later placement (col. 13, ll. 20-50).

Regarding dependent claim 5, Hanson discloses controls for generating objects (col. 7, ll. 25-28).

Regarding dependent claim 6, Hanson teaches receiving input from a designer, comprising an object with properties (col. 4, ll. 26-39). Hanson teaches converting and outputting HTML that is a representation of the object (col. 4, ll. 43-45). Hanson does not teach reconvert HTML to objects. Popp teaches converting an HTML document into objects based on the HTML. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Popp with Hanson because the text form of HTML cannot be easily extended and specialized like objects can (Hanson, col. 4, ll. 19-20).

As this conversion changes an object to code equivalent to the object, and then changes the code back to an object equivalent to the code, inherently the objects are the same.

Regarding dependent claim 7, Neither Hanson or Popp explicitly discloses the first and second program being the same. However, it would have been obvious to one of ordinary skill in the art

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at the time of the invention that slight difference would appear in the conversion, rendering them different programs.

Regarding dependent claim 15, Hanson teaches that markup language is HTML (col. 4, ll. 43-45).

Regarding Claims 8-14 and 16, the methods encompassing the same limitations as claims 1-7 and 15 are rejected under the same rationale.

Response to Arguments

9. **Applicant's arguments filed 9/8/2004 have been fully considered but they are not persuasive.**

Regarding Applicant's remarks on the §112 rejections:

Applicant has alleged that the amendment renders the rejection moot. The Office disagrees, and the rejection can be found above.

Regarding Applicant's remarks on claim 1:

Applicant alleges the concept of an event-handler is completely dissimilar to the concept of an event driven format. This further shows the ambiguity in the claim language, as the Office believes them to be practically the same thing.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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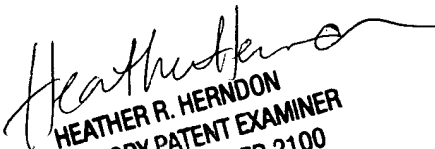
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AQ


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